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REMARKS

Reconsideration and withdrawal of the rejections made in the mentioned Office Action are respectfully requested, in view of the foregoing amendments and the following remarks:

Summary of Amendments

By the foregoing amendments claims 1-29 are canceled and new claims 30-56 are added, whereby claims 30-56 are pending in the present application. Claim 30 is the only independent claim. Support for the new claims can be found throughout the specification and, particularly, in originally filed claims 7-20 and at page 34 of the present application. In this regard, it is noted that claim 30 replaces claims 7 and 8, claims 31-33 replace claims 9-11, and claims 34-37 are claims which are generally based on claims 9 and 11 and on page 34 of the specification. Claims 38-39 replace claims 12 and 13, claims 40-47 replace claim 14, claims 48-49 replace claim 15, claims 50-51 replace claim 16, claims 52-53 replace claim 17, claim 54 replaces claim 18, and claims 55-56 replace claim 19.

It is noted that the cancellation of claims 1-29 is without prejudice or disclaimer to the prosecution of these claims in one or more divisional and/or continuation applications. Furthermore, any amendments to the claims which have been made in this Amendment, and which have not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Summary of Office Action

As an initial matter, Applicants note with appreciation that the claim for foreign priority under 35 U.S.C. § 119(a)-(d) and receipt of the certified copies of the priority documents in this National Stage application from the International Bureau have been acknowledged in the present Office Action.

However, Applicants note that initialed and signed copies of the Forms PTO-1449 submitted in the Information Disclosure Statements filed on January 24, 2002 and February 19, 2002 have not been returned together with the Office Action. In view thereof, Applicants respectfully request that duly initialed and signed copies of these two Forms PTO-1449 be returned together with the next communication from the Patent and Trademark Office.

The restriction requirement is made final and parts of claims 1-3, 5 and 7-21 and claims 4, 6 and 22-29 are withdrawn from consideration. The elected group VI is indicated in the paragraph bridging pages 5 and 6 of the present Office Action.

Claim 19 is rejected under 35 U.S.C. § 101 because it allegedly recites an improper definition of a process.

Claims 16, 17 and 21 are rejected under 35 U.S.C. § 112, first paragraph, since the specification allegedly does not reasonably provide enablement for the prophylaxis/treatment of the diseases recited in these claims.

Claims 1-3, 5, 7-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1-3 and 5 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Brunton, et al., J. Chem. Soc. (1956), pp. 4783-4785, and Grammaticakis, Compt. Rend. (1960), 251, pp. 2728-2730.

Claims 1-3, 5 and 7-21 and claims 4, 6 and 22-29 are objected to under 37 C.F.R. 1.142(b) as being drawn to non-elected subject matter.

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested.

Response to Rejection under 35 U.S.C. § 101

Claim 19 is rejected under 35 U.S.C. § 101 because the claimed recitation of a use, without setting forth any steps involved in the process, allegedly results in an improper definition of a process. Since claims 55 and 56 (which replace claim 19) recite a step involved in the process ("combining") this rejection is moot and withdrawal thereof is respectfully requested.

Response to Rejection under 35 U.S.C. § 112, First Paragraph

Claims 16, 17 and 21 are rejected under 35 U.S.C. § 112, first paragraph. In this regard, the Examiner takes the position that the specification, while being enabling for treating some NPY diseases such as diabetes, hypercholesterolemia, hyperlipidemia or arteriosclerosis, allegedly does not reasonably provide enablement for prophylaxis for diabetes, hypercholesterolemia, hyperlipidemia or arteriosclerosis or the treatment of all NPY diseases. Since the present claims do not recite any of the subject matter which the Examiner considers not enabled, this rejection is moot,

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and withdrawal thereof is respectfully requested. It is pointed out, however, that the deletion of the subject matter which in the Examiner's opinion is not enabled must not be construed as Applicants' admission that the Examiner's arguments in this regard are of any merit. Rather, the deletion of this subject matter merely serves to help expedite the issuance of a patent on the claims submitted herewith.

Response to Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1-3, 5, 7-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 19 is rejected because it allegedly does not set forth any steps involved in the method/process, and it is allegedly unclear what method/process Applicant is intending to encompass. Claims 1-3, 5, 7-21 are rejected as unclear, because it allegedly is unclear whether the subject matter in the parentheses is part of the claimed subject matter or not. The Examiner suggests amending the claims to delete the parentheses to obviate the rejections. Claims 14-17 are rejected as being indefinite, because it allegedly is unclear whether Applicant is claiming a pharmaceutical composition or a method of use. Claims 14 and 19 are rejected as allegedly lacking antecedent basis in claim 1 because of the recitation therein of a "substance" of claim 1.

Applicants note that none of the above rejections applies to any of the claims submitted herewith. In particular, claims 55 and 56 (which replace claim 19) clearly set forth a process step, do not contain any parenthesis and do not recite a "substance". None of the remaining claims submitted herewith contain any parenthesis and/or recite a "substance", either. Moreover, all of claims 40-53 (which replace claims 14-17) are clearly directed to a medicament, i.e., a pharmaceutical

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composition. Accordingly, in view of the claims submitted herewith the present rejection is moot and withdrawal thereof is respectfully requested.

Response to Rejection under 35 U.S.C. § 102(b)

Claims 1-3 and 5 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Brunton et al., and Grammaticakis.

Applicants note that the claims submitted herewith do not recite any of the subject matter which the Examiner regards as anticipated by the cited documents, wherefore the present rejection is moot and a discussion of the cited documents can be dispensed with. It is pointed out, however, that the deletion of the corresponding subject matter must not be construed as Applicants' admission that the Examiner's arguments in this regard are of any merit. Rather, the deletion of this subject matter merely serves to help expedite the issuance of a patent on the claims submitted herewith.

For the foregoing reasons, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

Response to Objection under 37 C.F.R. 1.142(b)

Claims 1-3, 5 and 7-21 and claims 4, 6 and 22-29 are objected to under 37 C.F.R. 1.142(b) as being drawn to non-elected subject matter.

Since the claims submitted herewith do not recite any non-elected subject matter, this objection is rendered moot.

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CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully submitted,
Naoyuki NISHIKAWA et al.



Bruce H. Bernstein
Reg. No. 29,027

Reg. No.
31,296

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191